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JUN 21 2004

OFFICE OF PETITIONS

In re Application of :
Olivera, McIntosh, Yoshikami, :
Cartier, and Luo : DECISION REFUSING STATUS
Application No. 09/897,465 : UNDER 37 CFR 1.47(a)
Filed: 3 July, 2001 :
Attorney Docket No. 2314-236 :

This is in response to the petition filed under 37 CFR 1.47(a)¹ on 3 July, 2001.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 3 July, 2001, with a declaration naming Baldomero M. Olivera, J. Michael McIntosh, Doju Yoshikami, G. Edward Cartier, and Sigin Luo as joint inventors and signed by all inventors except Olivera on behalf of themselves and joint inventor Olivera.

Petitioners assert, in a declaration by Lloyd Sadler, that joint inventor Olivera is out of town and cannot be reached.

¹A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign. Accordingly, the petition will be treated as a petition under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1) and (2).

In regards to item (1), petitioners have not provided sufficient proof that diligent efforts were made to contact the non-signing inventor. While Mr. Sadler states that "formal papers" were faxed by Ms. Shaleen Watkins to the inventors who had not executed the declarations, petitioners have not provided a statement by Ms. Watkins, the individual who has first-hand knowledge of the details of the circumstances under which the papers were sent, stating that a copy of the application papers (specification, including claims, drawings, if any, and the declaration) were sent or given to non-signing joint inventor Olivera. At a minimum, petitioners must send or give a copy of the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor.² Petitioners may provide proof by submitting a copy of the cover letter transmitting the application papers to the non-signing inventor at his last known address or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event the inventor refuses to sign the declaration,³ petitioners may show proof by providing a copy of any written refusal received from the non-signing inventor. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

²MPEP 409.03(d).

³Id.

If the application is returned as undeliverable, petitioners should submit a copy of the envelope showing that the application sent to the last-known address was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details. The fact that the non-signing inventor is out of town or on vacation is not a reason for filing under 37 CFR 1.47.

With regard to item (2), the declaration provided with the petition is defective in that Mr. Sadler has signed in the space provided for joint inventor Olivera's signature. All the signing inventors must sign the declaration for application on behalf of themselves and on behalf of the non-signing inventor. A declaration is acceptable if all the signing inventors signed in their respective signature blocks and the signature block of the non-signing inventor is left blank or all the signing inventors sign a statement a statement saying that they are signing on behalf of the non-signing inventor. There is no provision under 37 CFR 1.47(a) for another individual who is not an inventor to sign on behalf of the non-signing inventor. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and on behalf of the non-signing inventor, is required with any renewed petition.

Additionally, the declaration contains is defective in that it contains non initialed and/or non-dated alterations.⁴ Specifically, there is an uninitialed and/or undated alteration in the signature block for joint inventor Cartier. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by the inventor to whom the error or deficiency relates is required.⁵

It is additionally noted that the present petition appears to be a copy of a petition filed in Application No. 09/219,446, of which the present application is a division.

37 CFR 1.64(d)(3) provides, in pertinent part

Where the executed oath or declaration of which a copy is submitted for a continuation or divisional

⁴See 37 CFR 1.52(c).

⁵37 CFR 1.67(a)(2).

application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:

(I) a copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c)

As such, petitioners should submit a copy of the decision granting Rule 47(a) status in the prior application with any renewed petition.

The petition fee of \$130.00 has been charged to counsel's deposit account, No. 02-2135, as authorized in the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petition
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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Office of Petitions

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